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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 10/717,722 | 11/20/2003 | Kazufuku Nitta | NAI121791 | 8696 |
| 26389 7590 12/21/2007 CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347 | | | | |
| EXAMINER NASSER, ROBERT L | | | | |
| ART UNIT 3735 | | PAPER NUMBER | | |
| MAIL DATE 12/21/2007 | | DELIVERY MODE PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/717,722

Applicant(s)

NITTA ET AL.

Examiner

ROBERT L. NASSER

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-13 is/are pending in the application.
4a) Of the above claim(s) 6-12 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3 and 13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Applicant's election of Species I, claims 1-5 in the reply filed on 2/8/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Accordingly, claims 6-12 are withdrawn from consideration.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56. Rather, it states that ... to be material to EXAMINATION ... 37 CFR 1.56(a). The words the examination should be changed to patentability and 1.56(a) should be changed to 1.56.

Claims 1-3 and 13 are objected to in that the scope of the claim is unclear. Applicant states that the claim does not include the respiratory circuit, but rather just the sensor. However, the claim clearly positively claims the respiratory circuit, but stating that the main body is affixed to the respiratory circuit. This makes the circuit a positive element in the claim. In addition, claim 13 clearly recites a heater in the circuit. Accordingly, the examiner is treating the claim as being drawn to the combination of the

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sensor and the respiratory circuit. If applicant wishes to only claim the sensor, the claim should be amended to recite that the sensor is adapted to be affixed to the circuit.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clawson et al 4453835 in view of Tillotson et al 5676132.. Clawson shows a temperature probe for use in measuring the temperature of respiratory gases supplied to an infant in an incubator comprising a holder including a main body 18 affixed to a respiratory circuit. The examiner notes that since the entire device is connected to the circuit, element 18 is at least indirectly connected to the circuit. Clawson further has a protrusion which is comprised of element 62, which has a curved heat transfer suppressing portion 60 connected thereto, and where the sensor 102 is affixed in the vicinity of the tip of the protrusion 62. The examiner notes that only the sheath portion extending outwardly from the housing is in the circuit, but Clawson does not show the circuit. Tillotson is selected to show the typical position of a temperature sensor in a respiratory circuit. So such, it would have been obvious to position the sensor of Clawson in the manner shown by Tillotson, as it is merely the use of a known sensor position in the art. As such, based on the relative size of the sheath and the housing 60

and 62, it is clear that protrusion has a length longer than the diameter of the circuit.

With respect to claim 13, the heater is inherently upstream of the sensor. The examiner notes that whether to install the device with the curve facing left or right would have been a mere matter of design choice for one skilled in the art.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clawson in view of Tillotson et al as applied to claims 1, 2, and 13 above, and further in view of Doniguian 3680557. Doniguian teaches locating the temperature sensor in the incubator. As such, it would have been obvious to modify the above combination to locate the sensor in the incubator, as it is merely the substitution of one known sensor position for another.

Applicant's arguments filed 10/4/2007 have been fully considered but they are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT L. NASSER whose telephone number is (571)272-4731. The examiner can normally be reached on m-f 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert L. Nasser Jr/
Primary Examiner
Art Unit 3735

RLN
December 20, 2007